

## **REMARKS**

This paper is presented in response to the Office Action. No claims are canceled, amended or added by this paper. Accordingly, claims 1-43 remain pending.<sup>1</sup>

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

#### **A. Claim Amendments and/or Cancellations**

Although Applicants have not amended the claims herein, Applicants, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim amendments set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

#### **B. Remarks**

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the

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<sup>1</sup> Applicants note that the Office Action Summary asserts that only claims 24-43 are pending in the application. This is incorrect. Claims 1-23 are also pending, as those original claims have never been cancelled by the Applicants.

purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

## **II. Rejection of Claims 24 and 26-33 under 35 U.S.C. § 102**

Applicants respectfully note that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (c) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP § 2131*.

The Examiner has rejected claims 24 and 26-33 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,665,498 to Jiang et al. ("*Jiang*"). Applicants respectfully disagree, inasmuch as Applicants have reviewed the cited portions of *Jiang* and have been unable to reconcile the allegations of the Examiner with *Jiang*.

For example, in the rejection of independent claim 24, the Examiner has alleged that *Jiang* discloses:

"... receive path bypass circuitry (i.e., ASIC 212, Fig. 2) configured so that when the first data stream has a data rate less than about 10Gb/s, the first data stream bypasses the receive path eye opener circuitry along a first bypass path (i.e., [col.] 3, lines 34-67, col. 4, lines 1-67 and col. 5, lines 1-48)... [and] transmit path bypass circuitry (i.e., ASIC 212, Fig. 2) configured so that when the second data stream has a data rate less than about 10Gb/s, the second data stream bypasses the transmit path eye opener circuitry along a second bypass path, the second bypass path being in communication with the TOSA (i.e., [col.] 3, lines 34-67, col. 4, lines 1-67 and col. 5, lines 1-48)."

However, Applicants can find no discussion of any sort of "bypass circuitry" within the cited portions of the *Jiang* reference, let alone bypass circuitry configured as required by the rejected claims. The cited Figure 2 of *Jiang* also does not show or imply bypass circuitry. Furthermore, Applicants can find no discussion within the cited portions of *Jiang* that address the notion, recited in the claims, of treating data streams differently based on the data rate of the data stream.

Applicant notes further that the rejection appears to be somewhat illogical, in that the Examiner has alleged that ASIC 212 of *Jiang* corresponds both to the claimed "receive path eye opener circuitry" and to the claimed "receive path bypass circuitry." *Office Action* at 2-3.

In view of the foregoing, Applicants respectfully submit that it is clear that the Examiner has failed to establish that *Jiang* anticipates claim 24, at least because the Examiner has not established that each and every element as set forth in claim 24 is found in *Jiang*, because the Examiner has not established that the identical invention is shown in *Jiang* in as complete detail as is contained in claim 24, and because the Examiner has not shown that *Jiang* discloses the elements arranged as required by claim 24. Applicants thus respectfully submit that the anticipation rejection of claim 24, as well as the rejection of corresponding dependent claims 26-33, should be withdrawn.

### **III. Rejection of Claims 25 and 34-38 under 35 U.S.C. § 103**

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 25 and 34-38 under 35 U.S.C. § 103(a) as being obvious over *Jiang* in view of U.S. Patent Application Publication No. 2004/0033079 to Sheth et al. ("*Sheth*"). *Sheth* is cited simply for allegedly teaching a transceiver module that "is substantially compliant with the XFP MSA." Applicants respectfully disagree.

#### **i. claims 25 and 34:**

Inasmuch as the rejection of claims 25 and 34, which depend from claim 24, depends on the characterization of *Jiang* advanced by the Examiner in connection with the rejection of claim 24, the rejection of claims 25 and 34 lacks an adequate basis for at least the reasons set forth at II. above. By way of example, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 25 and 34 at least because the Examiner has failed to establish that *Jiang*, when combined with *Sheth* in the purportedly obvious fashion, teaches or suggests all the limitations of the rejected claims. Applicants thus respectfully submit that the rejection of claims 25 and 34 should be withdrawn.

#### **ii. claims 35-38**

Independent claim 35 recites "receive path bypass circuitry configured so that when the first serial data stream has a data rate of about 8.5Gb/s, the first serial data stream bypasses the receive path eye opener circuitry along a first bypass path; ... [and] transmit path bypass circuitry configured so that when the second serial data stream has a data rate of about 8.5Gb/s, the second serial data stream

bypasses the transmit path eye opener circuitry along a second bypass path, the second bypass path being in communication with the TOSA, and the transceiver module being substantially compliant with the XFP MSA.” As discussed at II. above however, the Examiner has not established that *Jiang* or *Sheth* or any other reference(s) teach or suggest bypass circuitry of any kind, let alone bypass circuitry configured as required by the rejected claims.

Furthermore, Applicants can find no discussion within the cited portions of *Jiang* or *Sheth* of the claimed notion of treating data streams differently based on the data rate of the data stream. In fact, Applicants can find no teaching or suggestion within *Jiang* or *Sheth* concerning the use of a “data rate of about 8.5 Gb/s,” as recited in claim 35.

In view of the foregoing, Applicants respectfully submit that the Examiner has not established that the aforementioned limitations, in combination with the other limitations of rejected claim 35, is taught or suggested by *Jiang* or *Sheth* or by any other reference(s). Thus, the Examiner has not shown that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of the claims. Applicants thus respectfully submit that the obviousness rejection of claim 35, as well as the rejection of corresponding dependent claims 36-38, should be withdrawn

#### **IV. Allowable Subject Matter**

The Examiner’s allowance of claims 39-43 is appreciated. Applicants wish to thank the Examiner for the careful review and allowance of those claims.

#### **V. Claims 1-23**

As noted above, the Office Action has incorrectly asserted that only claims 24-43 are pending in the application. Apparently because of this, the Office Action has failed to address the patentability of claims 1-23. Nonetheless, Applicants respectfully submit that claims 1-23 are in allowable condition.

**CONCLUSION**

In view of the remarks submitted herein, Applicants respectfully submits that each of the pending claims 1-43 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 9th day of January 2008.

Respectfully submitted,

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